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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09,989,365      | 11/20/2001  | George F. Fanta      | 0152.98             | 1129             |

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USDA-ARS-OFFICE OF TECHNOLOGY TRANSFER  
NATIONAL CTR FOR AGRICULTURAL UTILIZATION RESEARCH  
1815 N. UNIVERSITY STREET  
PEORIA, IL 61604

EXAMINER

BISSETT, MELANIE D

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/989,365

Applicant(s)

FANTA ET AL.

Examiner

Melanie D. Bissett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 2-24 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 2,3,5,6 and 23 is/are rejected.
- 7) ☐ Claim(s) 4,7-12,21,22 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. The rejections based on 35 USC 112 and most of the rejections based on 35 USC 102 have been withdrawn based on the applicant's amendments.

***Election/Restrictions***

2. Applicant's election with traverse of Group I in Paper No. 5 is acknowledged. The traversal is on the ground(s) that a search for the product would uncover prior art for the method. This is not found persuasive because the product and process would require a separate search strategy. It has been shown that the product and process would have separate classifications. Additionally, it is noted that a search for the product would not require a search for the process steps of contacting the coating at a temperature above its gelling temperature and holding the materials in contact until the coating cools. Likewise, a search for the method would not require a search for a specified thickness of coating. Note that the process claims will be rejoined with the product claims upon allowance of the product claims only if the product claims recite all of the limitations of the independent product claim.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 2-3, 5-6, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Top Foods. Note that a machine translation of the Japanese reference has been provided for the applicant's convenience.

5. Top Foods discloses a plastic film coated with a starch, where the example shows the use of polyethylene as the plastic film (abstract; example). The coating has a thickness of about 1-3  $\mu\text{m}$ , which anticipates the applicant's claimed range of approximately 1  $\mu\text{m}$  or less.

***Allowable Subject Matter***

6. Claims 4, 7-12, 21-22, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The closest prior art, Top Foods, discloses a transfer sheet having a soluble starch coating on a plastic film. However, the reference does not specify the amylose content of the starch used, the coating weight, the extent of solubilization, or the cooking method of the starch. Additionally, the reference does not mention three-dimensional substrates or the presence of nodules in the coating. It is the examiner's position that these limitations, when combined with the applicant's claimed article of manufacture, would provide novel and unobvious steps over the prior art.

### ***Response to Arguments***

8. In response to the applicant's argument that the reference does not teach solubilized starch because it is not clear that the reference intends truly soluble starch solutions, it is the examiner's position that one of ordinary skill in the art would assume that descriptions of dissolving starch in water and soluble starch convey a solubilized starch system. Although the applicant argues that the literature speaks loosely of starch dispersions as solutions, the applicant has provided no evidence or direct support that the Top Foods reference intends the use of starch dispersions instead of starch solutions. Regardless of the method of forming or modifying the starch, the reference specifically teaches dissolving starch in water. Without evidence to the contrary, it is the examiner's position to treat the reference as teaching the dissolution of starch in water.

9. Regarding the applicant's argument that the reference does not intend to firmly attach the starch coating to the plastic film, it is noted that "adherent, firmly attached hydrophilic coating" is a relative term. A temporary adhesion is an adhesion nonetheless. Since the starch coating is attached to the plastic film for transfer to food articles (see Figures I-IV), it is the examiner's position that the coated film meets the limitation of "adherent, firmly attached".

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (703) 308-6539. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

mdb

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A handwritten signature in black ink, appearing to read "J. L. Kim".

Signature of J. L. Kim  
Inventor